REMARKS

Claims 4-6 have been added. Specifically, claims 4-6 add the limitation that the axle lies between the output shaft and internal teeth of the internally toothed gear or gear segment. Support may be found in Fig. 1, and in the Specification, page 3, first full paragraph.

The Drawings have been amended to correct a duplicative reference number. The Specification has been amended to reflect this correction.

No new matter has been added.

Objections

The Examiner objected to the wording of the Abstract and claims 1 and 3. These objections are addressed in this Amendment.

A. The Rejections

1. 35 U.S.C. 112, 1st ¶

Claim 3 stands rejected under 35 U.S.C. 112, 1st ¶, as failing to comply with the enablement requirement.

2. 35 U.S.C. §102(b) Rejections

Claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al. (U.S. Pat. No. 6,007,446) (hereinafter "Lang").

Claims 1 and 2 stand rejected under 35 U.S.C. l02(b) as being anticipated by Misic (U.S. Pat. No. 2,499,928) (hereinafter "Misic").

B. Applicants' Arguments

1. 35 U.S.C. 112, 1st ¶

Claim 3 stands rejected under 35 U.S.C. 112, 1st ¶, as failing to comply with the enablement requirement. The Office Action states that "[i]t is unclear of the structure of the

internal gear or internal gear segment to make it possible to rotate 360° about the axis of the output shaft 22 while it would not be obstructed by the axle 18." (Office Action mailed June 16, 2008, section 6) (hereinafter "Office Action".) However, nothing in claim 3 requires the structure to be able "to rotate 360° about the axis of the output shaft 22". The utility of an actuating device does not depend upon the axis of the output shaft being able to rotate 360°. For example, rotating eccentric 24 by 90° would be sufficient to operate a valve rod. Therefore, Applicants respectfully request that the application be reconsidered and that the rejection of claim 3 be withdrawn.

2. 35 USC §102(b)

Anticipation under 35 U.S.C. § 102 requires showing the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). In this case, the Examiner has failed to establish a prima facie case of anticipation against claim 1 because Lang fails to teach, or even suggest, each and every element of claim 1.

a. Lang does not disclose or suggest the "drive shaft" of claim 1

In describing the disclosure of Lang, the Office Action states that "electric motor 8 ...drives a drive shaft (i.e., the shaft that has the sun gear 21 mounted on)". (Office Action, section 8.). However, the shaft on which sun gear 21 is mounted is not a drive shaft but rather a "cylindrical axle 46". (Lang, col. 3, lines 19-20.) This axle 46 "is press fit into a recess 47 in the housing under-piece 1 making the axle 46 non-rotating in respect to housing under-piece 1." (Lang, col. 3, lines 20-22.) Because this axle 46 does not rotate, it is not a "drive shaft" and can not anticipate or suggest the "drive shaft" of claim 1.

b. Lang does not disclose or suggest the "drive gear arranged on the drive shaft ... in a rotationally fixed manner" of claim 1

The Office Action states that Lang discloses "a gear unit comprising a drive gear 21 arranged on the drive shaft at least in a rotationally fixed manner". (Office Action, section 8.) However, gear 21 is not mounted in a rotationally fixed manner to the axle 46. As shown above, axle 46 does not rotate; rather, "axle 46 [is] non-rotating". (Lang, col. 3, 22-23.) For drive gear 21 to operate at all, drive gear 21 must rotate about axle 46. Therefore, drive gear 21 is not "arranged on [axle 46]...in a rotationally fixed manner" as required by claim 1. The combination of drive gear 21 and axle 46 thus fail to anticipate or suggest "a drive gear arranged on the drive shaft at least in a rotationally fixed manner" as required by claim 1.

c. Lang fails to disclose or suggest a "planetary gear...supported on an axle in a fixed position" as required by claim 1

Lang discloses "a sun gear 21". (Lang, col. 2, lines 47-48.) "The outer cogging 22 of sun gear 21 accommodates three planetary gears 23...engaging [them] with their corresponding outer cogging 24." (Lang, col. 2, lines 49-52.) The Office Action states that Lang discloses "one or more planetary gears (23, 32), each planetary gear comprising a double gear having a larger gear wheel 23 and a smaller gear wheel 32 supported on an axle 29 in a fixed position and so that the planetary gear can pivot". (Office Action, section 8.) However, axle 29 is not "in a fixed position" as required by claim 1. "The planetary gears 23 are rotatably borne on bearing pins 29 of a web under-piece 30". (Lang, col. 2, lines 59-60.) Furthermore, "the planetary gears engagingly contact an annular hollow gear 25, which is provided with an inner cogging 26, into which the respective outer cogging 24 of the planetary gears 23 fit." (Lang, col. 2, lines 52-55.) "The annular gear 25 is non-rotatable in respect to the housing". (Lang, col. 2, lines 55-56.) Because the annular gear 25 is fixed to the housing and the planetary gears 23 engage the annular gear 25, the planetary gears 23

must revolve around the sun gear 21. Because the planetary gears 23 are mounted on bearing pins 29, the bearing pins 29 must also revolve around the sun gear 21. Thus, bearing pins 29 of Lang do not anticipate or suggest a "planetary gear...supported on an axle in a fixed position" as required by claim 1.

d. Misic fails to disclose or suggest the "internally toothed gear or gear segment that is arranged on an output shaft in an at least rotationally fixed manner" of claim 1

The Office Action asserts that Misic discloses "an internally toothed gear or gear segment 72 (note gear segment is defined as in axial direction) that is arranged on an output shaft 67 in an at least rotationally fixed manner, wherein the drive gear 62 in a first gear stage meshes with at least one planetary gear 79, whereby the drive gear 62 drives the larger gear wheel 79 of the double gear, and the smaller gear wheel 80, which faces a direction of an output side, in a second gear stage meshes with the internally toothed gear or gear segment 72". (Office Action, section 9.) However, item 72 in Misic is not an "internally toothed gear or gear segment" as required by claim 1. Misic calls item 72 "gear 72". (Misic, col. 5, line 24.) Misic's gear 72 is externally toothed, not internally toothed. (Misic, FIG. 3.) Therefore, Misic's gear 72 does not anticipate "an internally toothed gear or gear segment that is arranged on an output shaft in an at least rotationally fixed manner" as required by claim 1. Because Misic fails to disclose each and every limitation of claim 1, Misic fails to anticipate claim 1, and therefore the application should be reconsidered and this rejection of claim 1 should be withdrawn.

For all the reasons above, the application should be reconsidered and the rejection of claim 1 should be withdrawn. Therefore, the rejection of dependent claims 2 is moot, and the applicants request that the application be reconsidered and the rejection of claim 2 be withdrawn.

CONCLUSION

In view of the present amendment, applicants respectfully assert that all pending claims are in condition for allowance and a prompt notice of allowance is earnestly solicited.

The below-signed attorney for applicant welcomes any questions.

Respectfully submitted,

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